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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,500	09/30/2003	Kazuhiro Kuwabara	117369	2323

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EXAMINER	
NGUYEN, QUYNH H	

ART UNIT	PAPER NUMBER
2614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/673,500	KUWABARA ET AL.	
	Examiner	Art Unit	
	QUYNH H. NGUYEN	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *amendment filed 4/18/08*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10 and 12-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10 and 12-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

2. Applicant's amendment filed 4/18/08 has been entered. Claims 1, 4, 6, and 9 have been amended. Claim 11 has been canceled. Claims 12-15 have been added. Claims 1-10 and 12-15 are still pending, with claims 1 and 6 being independent.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg,* 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman,* 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi,* 759 F.2d 887,225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum,* 686 F.2d 937,214 USPQ 761 (CCPA 1982); *In re Vogel,* 422 F.2d 438, 164

USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/634828. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards an IP phone device with capabilities of transmitting signals to connect with either a phone or internet network.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shnitzer et al, US Patent 7,061,901 (hereinafter referenced as Shnitzer) in view of Prentice (US Patent 7,023,987).

As to claim 1, Shnitzer teaches an IP phone device comprising:

an NCU connected to a phone network (Fig. 5, DAA 130);

a handset that is used for making phone calls with a remote phone device through the NCU and the phone network while exchanging audio signals (col. 5, lines 59-61, note that fig. 1, element 100 displays a handset. Additionally, Col. 3, lines 40-48 teach that signaling is received by the PSTN/Switch 105 to establish a connection);

an audio interface (fig. 1, element 160) responsive to an Internet telephony execution instruction, for inputting and outputting the audio signals for the phone calls to and from a remote IP phone device through Internet via the computer (col. 8, lines 43-60) ;

call-start instruction input means for inputting a call-start instruction for Internet telephony in accordance with user's actions (col. 14, lines 19-29);

path switching means (fig. 1, element 150) for switching a path from the NCU to the audio interface to output an audio signal input through the handset and to input an audio

signal output from the handset through the audio interface when the call-start instruction for Internet telephony is input from the Call-start instruction input means (col. 3, lines 40-47 and col. 7, lines 25-28);and

computer control means (fig. 1, element 180) for outputting control commands to a computer for executing Internet telephony to the computer from the audio interface when the call-start instruction for Internet telephony is input from the call-start instruction input means, the control commands being output in the form of an audio signal, the computer executing transmission/reception of the audio signals to and from the remote IP phone device (col. 14 lines 19-40, note that element 160 sends DTMF signals to element 180 which sends the signals to the computer, wherein the computer has element 190. Additionally, element 190 is able to acknowledge if the signal received is going to generate a call, and communicate the results back to the phone).

Shnitzer does not teach computer control means for launching Internet telephony application software and outputting control commands to a computer for executing Internet telephony.

Prentice teaches computer control means for launching Internet telephony application software and outputting control commands to a computer for executing Internet telephony (col. 6, lines 52-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Prentice into the teachings of

Shnitzer for the purpose of having a more efficient system and functionality be used to select what type of application software from the Internet to launch.

As to claim 2, Shnitzer teaches that the computer control means outputs the control commands in the form of a DTMF signal to the computer (col. 14, lines 25-27):

As to claim 3, Shnitzer teaches a phone device connection means for connecting a sub-phone device for allowing the sub-phone device to make phone calls with the remote IP phone device, the computer control means receiving the control commands from the sub-phone device through the phone device connection means and transmitting the control commands to the computer in the form of a DTMF signal (col. 8, lines 32-37 teach that a cellular implementation of device 100 could be implemented, wherein the cellular implementation would be a wireless sub- terminal. Additional, col. 6, lines 11-16 teach that different phones can be connected to the same terminal).

As to claim 4, Shnitzer teaches computer connection means for connecting to the computer connected to Internet to allow the audio signals and other signals to input from and output to the computer through the computer connection means (fig. 5, element 200 displays an interface connecting to a PC which is taught in col. 8 lines 4-8).

As to claim 5, Shnitzer teaches that the computer is connected through an audio cable (col. 7, lines 34-37).

As to claim 6, Shnitzer teaches an IP phone system comprising:

a computer connectable to Internet (fig. 1, element 16, also fig. 5, elements 195 and 190 are part pf the PC); and

an IP phone comprising: an NCU connected to a phone network (Fig. 5, DAA 130);

a handset that is used for making phone calls with a remote phone device through the NCU and the phone network while exchanging audio signals (col. 5, lines 59-61, note that fig. 1, element 100 displays a handset. Additionally, Col. 3, lines 40-48 teach that signaling is received by the PSTN/Switch 105 to establish a connection);

an audio interface (fig. 1, element 160) responsive to an Internet telephony execution instruction, for inputting and outputting the audio signals for the phone calls to and from a remote IP phone device through Internet via the computer (col. 14, lines 19-29);

call-start instruction input means for inputting a call-start instruction for Internet telephony in accordance with user's actions (col. 14, lines 19-29);

path switching means (fig. 1, element 150) for switching a path from the NCU to the audio interface to output an audio signal input through the handset and to input an audio signal output from the handset through the audio interface when the call-start instruction for Internet telephony is input from the call-start instruction input means (col. 3, lines 40-47 and col. 7, lines 25-28); and

computer control means (fig. 1, element 180) for outputting control commands to the computer for executing Internet telephony to the computer from the audio interface when the call-start instruction for Internet telephony is input from the call-start instruction input means, the control commands being output in the form of an audio signal, the computer executing transmission/reception of the audio signals to and from the remote IP phone device (col. 14, lines 19-40, note that element 160 sends DTMF signals to element 180 which sends the signals to the computer, wherein the computer has element 190. Additionally, element 190 is able to acknowledge if the signal received is going to generate a call, and communicate the results back to the phone).

Shnitzer does not teach computer control means for launching Internet telephony application software and outputting control commands to a computer for executing Internet telephony.

Prentice teaches computer control means for launching Internet telephony application software and outputting control commands to a computer for executing Internet telephony (col. 6, lines 52-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Prentice into the teachings of Shnitzer for the purpose of having a more efficient system and functionality be used to select what type of application software from the Internet to launch.

As to claim 7, Shnitzer teaches the computer control means outputs the control commands in the form of a DTMF signal to the computer (col. 14, lines 25-27).

As to claim 8, Shnitzer teaches phone device connection means for connecting a sub-phone device for allowing the sub-phone device to make phone calls with the remote IP phone device, the computer control means receiving the control commands from the sub-phone device through the phone device connection means and transmitting the control commands to the computer in the form of a DTMF signal (col. 8, lines 32-37 teach that a cellular implementation of device 100 could be implemented, wherein the cellular implementation would be a wireless sub- terminal. Additional, col. 6, lines 11-16 teach that different phones can be connected to the same terminal).

As to claim 9, Shnitzer teaches computer connection means for connecting to the computer connected to Internet to allow the audio signals and other signals to input from and output to the computer through the computer connection means (fig. 5, element 200 displays an interface connecting to a PC which is taught in col. 8 lines 4-8).

As to claim 10, Shnitzer teaches the computer is connected through an audio cable (col. 7, lines 34-37).

As to claims 12-15, Prentice teaches voice input receives the voice input from the telephone (col. 5, lines 16-22). Prentice does not explicitly teach the computer control means outputs another audio signal command to check if the Internet telephony application software has been launched. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the above teachings into the teachings of Shnitzer and Prentice in order to have a more efficient system and to check for possible re-launching the software in case of technical difficulty.

Response to Arguments

6. Applicant's arguments with respect to claims 1-10 and 12-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to

5:00 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Quynh H Nguyen/

Primary Examiner, Art Unit 2614